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NOV 20 2000

REEXAM UNIT

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(For Requester)

In re reissue application of
Pervan
Application No. 09/343,696
Filed: June 30, 1999
For: U.S. Patent No. 5,706,621

In re Pervan
Reexamination Proceeding
Control No. 90/005,744
Filed: June 13, 2000
For: U.S. Patent No. 5,706,621

DECISION, SUA SPONTE,
TO MERGE REEXAMINATION
AND REISSUE PROCEEDINGS

The above noted reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,706,621 issued to Pervan on January 13, 1998.
2. On June 30, 1999, a reissue application was filed and assigned application no. 09/343,696, which amended claims 3 and 6, and added claims 24-40, and a notice of the reissue was published in the *Official Gazette* on August 31, 1999.
3. A nonfinal Office action was mailed in the reissue application on April 13, 2000.
4. On June 13, 2000, a request for reexamination of the '621 patent was filed by a third party requester, and was assigned Control No. 90/005,744.
5. On September 7, 2000, reexamination was ordered.
6. No patent owner's statement was filed in response to the order.

DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 C.F.R. § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted

separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue application shows that applicant has amended claims 3 and 6, and added new claims 24-40. A review of the reexamination file shows that reexamination was ordered on September 7, 2000, and is awaiting a first Office action. Original patent claims 1-23 have been filed in the reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination will be merged in accordance with the decision set forth below.

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. This maintenance of

identical amendments in the two files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

2. A proposed housekeeping amendment must be filed within ONE (1) month of the mailing date of this decision, to thereby place the same amendments in both cases. The housekeeping amendment should not address the issue of patentability. See 37 C.F.R. § 1.540.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

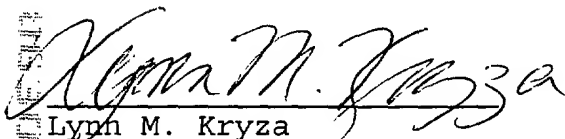
1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action.
2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).
4. Each Office action issued by the examiner will take the form of a single action which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data for both the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

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5. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing a signature, for entry in both files.
6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under § 1.570. See MPEP 2285.
7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.
8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (e.g., based on public use or sale), and any new grounds of rejection which are applicable under reexamination (e.g., improper broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).
9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continuation of prosecution of the reexamination proceeding.

CONCLUSION

1. The above noted reissue application and reexamination proceeding ARE MERGED.
2. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 3600. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding until the expiration of ONE (1) month from the mailing of this decision**, to allow for submission of a proposed housekeeping amendment, to thereby place the same amendments in both cases, as required in Part II, above.
3. All further examination should be conducted in accordance with Part III of this decision.
4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.



Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

November 17, 2000